

REMARKS

Applicants traverse the requirement for election of a single nucleic acid sequence and encoded amino acid sequence.

This application is a divisional continued prosecution application (CPA) of application number 09/533,029, in which a restriction requirement was entered by the Examiner in Paper No. 2, mailed July 21, 2000, which required the election of one of 19 families (Paper No. 2 at pp. 3-5). Apparently, the PTO recognized the core, structural similarities that exist within these groups and restricted the claims based on that knowledge. Applicants elected group H, directed to MYB genes. After the CPA was filed, applicants elected group E, directed to AP2 genes. As indicated by the Patent Office's own rules for examination practice at M.P.E.P. § 819,

... [w]hen a continued prosecution application (CPA) filed under 37 CFR 1.53 (d), is a continuation of its parent application and not a divisional ... an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant....

Clearly, the PTO's procedures, as given in the M.P.E.P., recognize and affirm that an original restriction requirement carries over to a CPA.

As provided for in the M.P.E.P., if the present application had been filed as a continuation CPA, the restriction requirement entered in the parent application would apply and applicants would be limited to pursuing the same group H, the MYB family of genes. In this divisional CPA, the restriction requirement carries over from the parent application, but the applicants have clearly indicated that they are electing to pursue a different group here – group E, drawn to the AP2 family of genes – in their January 28, 2002 Preliminary Amendment.

Given that the Examiner has already restricted applicants to one of the 19 families of genes (Paper No. 2 at pp. 3-5), and that applicants are in compliance with this restriction, applicants submit that any further restriction would be improper. Therefore, applicants respectfully submit that the "Election/Restriction" requirement of Paper No. 17 is only a requirement for election of species.

Furthermore, applicants traverse the requirement to elect a single nucleotide and amino acid species. As stated in M.P.E.P. § 803:

If the search and examination of an entire application can be made without a serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

This application presents no such burden. All of the sequences claimed are derived from the AP2 family of transcription factors. Additionally, all the transcription factors are derived from plants. The sequences recited in the claims are related and, for at least this reason, the claims reciting them can be examined and searched together. The Patent Office has failed to show that a burden exists in examining all the claims together, and thus, under M.P.E.P. § 803 the claims must be examined together. For these reasons, applicants request reconsideration.

Furthermore, the Patent Office insists that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another (*see* p. 2 of Paper No. 17). Without considering the merits of such a statement, applicants submit that the Patent Office's own rules for examination practice indicate that a burden in examining multiple nucleotide sequences does not exist. At M.P.E.P. § 803.04, the following text appears:

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three-dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten.

These rules clearly show and direct that at least ten different sequences can be and should be examined together. Thus, according to the Patent Office, there is no burden in searching at least

ten different sequences. Any reasoning suggesting that restriction and election of a single sequence is proper cannot be sustained. In the face of this clear indication that at least ten sequences should be examined together, the Patent Office has not shown why there is a burden in searching all the claims here, which contain only 7 nucleotide sequences along with the corresponding amino acid sequences. None of the reasons given for the restriction requirement implicate a serious burden.

Furthermore, the Patent Office has not addressed or provided any evidence or reasoning on the applicability of the “exceptional case” here. As noted in the rule quoted above, certain complexity requirements must be met for cases where the ten nucleotide examination rule is not employed. The Patent Office has not asserted that this case is exceptional or provided any evidence that it might be. Thus, applicants submit that the above-quoted rule applies to this application and the Patent Office should apply it in this application.

Additionally, applicants request clarification of the requirement to select a single sequence. The Patent Office insists that this requirement is not a requirement for the selection of a species (*see* pages 3 of Paper No. 17). However, the Patent Office has not indicated the authority for requiring an election of a single nucleotide sequence that is not a requirement for an election of species. On the other hand, the requirement for election of species is discussed at length in the M.P.E.P. at, for example, sections 806.04, 808.01, and 809.02. Applicants’ have entitled this paper a response to election of species in accordance with the accepted practice under these rules. And as provided under these and other rules, applicants reserve the right to request rejoinder of the remaining claims and species when the examination results in allowable subject matter or claims.


No extension of time fees or requests for extension of time, or any other fees or petitions, are believed to be necessary to enter and consider this paper. If, however, any petitions or extensions of time are required or any fees are due in order to enter or consider this paper or enter or consider any paper accompanying this paper, including fees for net addition of claims, or

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in order to keep this application pending, applicants hereby request any extensions or petitions necessary and the Commissioner is hereby authorized to charge Deposit Account No. 50-1129 for any fees.

Respectfully submitted,
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